

Please amend Claim 6 as follows:

6. (Amended) An apparatus as described in Claim 4 further comprising [at least one pipe attached to said cylindrical member] a spike disposed perpendicular to a longitudinal axis of said cylindrical member.

Please cancel Claim 7.

### RESPONSE

1. Claims 1 – 7 have been rejected under 35 U.S.C. § 112, first paragraph. The Office Action contends that the Applicant has failed to describe the invention in such a way as to reasonably convey to one skilled in the art that the Applicant had possession of the claimed invention.

With respect to Claims 1 and 4, the Office Action contends that the element “attachment means” is not described in the specification or the drawings. Applicant must contest the analysis set forth in the Office Action. Applicant has amended Claim 1 in order to clarify the attachment means as a “securing means”. Applicant plainly describes, on Page 2 of the specification (in the fourth sentence of the “Description of the Preferred Embodiment”) that “tails” are attached to the cylindrical member for the purpose of “securing” the bird guard to the wire.

With respect to Claims 2, 3, 5 and 6, Applicant believes that the clarification to Claims 1 and 4 as amended herein precludes a finding that these claims should be rejected under 35 U.S.C. § 112, first paragraph. Applicant notes that Claims 2 and 3 depend on Claim 1, now amended, and that Claims 5 and

6 depend on Claim 4. Applicant further notes that Claim 7 has been cancelled.

2. Claim 5 has been rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. The Office Action indicates that the term “voids” is confusing in light of the specification which teaches the use of a “notch”. In clarification, the Applicant has amended Claim 5; replacing the term “voids” with the term “notch”.
3. Claims 1 – 3 have been rejected under 35 USC § 103(a), obviousness. The Office Action has based the rejection of Claims 1 – 3 on a single reference, namely US Patent 4,280,013 issued to Clutter (hereinafter “Clutter”).

To support rejection of any claim under 35 USC § 103(a), the references cited in support of the rejection must satisfy the following criteria:

1. There must be some motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings;
2. There must be a reasonable expectation of success; and
3. The prior art reference (or references when combined) must teach or suggest all the claim limitations.

Applicant respectfully submits that the cited references do not offer any motivation to modify the references to make the claimed invention. Applicant also respectfully submits that the knowledge available to one of ordinary skill in the art would not have motivated the artisan to modify or combine the cited references to make the claimed invention. Further, the cited references do not teach or suggest all claim limitations of the claimed invention.

Applicant avers that Clutter does not teach the claim limitation of a cylindrical member. Hence, the first part of the prima facie case for obviousness is not satisfied and the rejection of Claim 1 must be withdrawn.

The Office Action purports that Clutter teaches a cylindrical member at Lines 19 – 23 of Column 3. This is not true.

The Office Action indicates that it would be obvious to modify Clutter's invention to render the claimed invention. Specifically, the Office Action relies on *Span-Deck Inc. v. Fab-Con, Inc.* (CA 8, 1982) 215 USPQ 835 that establishes the doctrine that the mere change in the shape of an object is not enough to establish patentability. While this is true, the modification to any reference must still satisfy the axiom that the modification must not make the reference unfit for its intended purpose.

Modification of the Clutter reference renders it unfit for its intended purpose. For the Patent Office to rely on a modified reference to sustain a rejection under 35 USC § 103(a), the proposed modification of the reference can not render the prior art unfit for its intended purpose.

Here, the Clutter reference teaches the use of an insulator cover that is shaped to cover an insulator that may be used to support an electrical wire on a power pole in an isolated manner. The cover taught by Clutter has a distinct shape, comprising a domed tent profile that may slide over an insulator (Column 3, Lines 35 – 40). The purpose for covering the insulator, as taught by Clutter, is to provide safety to human beings working on the line. It is intended to be a temporary safety device and is intended to protect persons that provide a path to ground.

Applicant avers that if Clutter's shape were to be changed to a "cylindrical member for engaging a wire" as Applicant now claims as his own, the

insulator receiving space so important to Clutter would be compromised rendering his invention unfit for its intended purpose. Applicant further notes that the title of Cutter's invention is "Insulator Cover"; this further supports Applicants contention that covering the insulator is the main object of Clutter. Again, if the Clutter reference were to be modified to render the claimed invention, it would no longer be capable of protecting against contact with the insulator. This could result in a lethal electrical current to flow from the insulator through grounded personnel.

With respect to the rejection of Claims 2 and 3, Applicant avers that the dependant Claims 2 and 3, stemming from Claim 1, are non-obvious. This is supported by *In re Fine*, 837, F.2d 1071, 5 USPQ2d 1596, Fed. Cir. 1988 wherein it was found that if an independent claim is non-obvious under 35 USC § 103, then any claim depending therefrom is non-obvious.

4. Claims 4 – 7 have been rejected under 35 USC § 103(a), obviousness. The Office Action has based the rejection of Claims 4 – 7 on Clutter in further view of US Patent 4,741,097 issued to D'Agati, et al. (hereinafter D'Agati). Applicant first contends that Claims 4 – 6 (whereas Applicant has cancelled Claim 7) are dependent on Claim 1 and cannot be held obvious in light of Applicant's showing that Claim 1 is non-obvious (*In re Fine*, *supra*).

In further rebuttal of the rejection of Claims 4 – 7, the Office Action contends that the use of a helical member for wrapping around a wire is obvious. Applicant disagrees.

The burden of establishing obviousness carries with it an obligation to set forth a convincing line of reasoning as to why an artisan would have modified and/or combined the reference teachings. Simply stating that "it would have been obvious" is insufficient to meet this burden. This, though, is all the Office Action has proffered in support of its burden. The Office Action has not

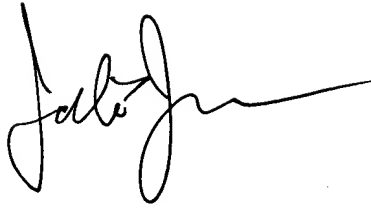
put forth any reasoning as to why the proposed modifications and combinations would be obvious.

The D'Agati reference cannot sustain a rejection of Claims 4 - 7 under authority of 35 USC § 103(a) because it is not founded in analogous art. For the Patent Office to rely on a reference to sustain a rejection under 35 USC § 103(a), the reference must be in the applicant's field of endeavor. If not, then reasonably pertinent to the particular problem with which the inventor was concerned.

It is clear to the Applicant that the field of the claimed invention is that of protecting an animal from electrically induced injury. D'Agati is concerned with installing electrical conductors, specifically tying wires to an insulator. Applicant avers that there is simply no motivation to consult the teachings of D'Agati when concerned with securing a wildlife protection apparatus to a power conductor. Especially in light of the fact that Applicant claims an invention that avoids the insulator with which D'Agati is concerned.

5. Attached hereto is a "Clean-Version" of the changes made to the claims by the current amendment. The attached page is captioned "Version Of Claims Showing Incorporation of Changes".
6. Based on the foregoing, Applicant considers the present invention to be distinguished from the art of record. Accordingly, Applicant respectfully solicits the Examiner's withdrawal of the rejections raised in the above referenced Office Action, such that a Notice of Allowance is forwarded to Applicant, and the present application is therefore allowed to issue as a United States patent.

Respectfully Submitted,



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Version Of Claims Showing Incorporation of Changes

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1. (Amended) An apparatus for protecting animals from contacting power lines comprising:  
a cylindrical member for engaging a wire; and  
securing means for securing said cylindrical member to said wire.

4. (Amended) An apparatus as described in Claim 1 wherein said securing means comprises at least one helical member for wrapping around said wire.

5. (Amended) An apparatus as described in Claim 4 further comprising a notch in said cylindrical member for accommodating an insulator as commonly disposed on a power pole.

6. (Amended) An apparatus as described in Claim 4 further comprising a spike disposed perpendicular to a longitudinal axis of said cylindrical member.